

**Remarks**

Claims 84-89 are pending in the Application.

Claims 87-89 stand rejected.

Claim 84-86 stand allowed.

Claims 87-89 are cancelled herein without prejudice.

**I. PRIOR ART REJECTIONS**

Examiner has rejected Claims 87-89 under 35 U.S.C. § 102(a) as being anticipated by Kiang *et al.*, “Carbon Nanotubes with Single-Layer Walls,” Carbon, 33(7), pp. 903-914, 1995 (“Kiang”). Office Action, at 3-4. When doing so, the Examiner has relied upon Dresselhaus *et al.*, Carbon Nanotubes: Synthesis, Structure, Properties, and Applications (“Dresselhaus”)<sup>1</sup> to show a “state of fact”<sup>2</sup> Office Action, at 3-4. Examiner has further rejected Claims 87-89 under 35 U.S.C. § 102(a) as anticipated by or, in the alternative under 35 U.S.C. § 103(a) as being obvious over Kiang with Dresselhaus. Office Action, at 4-5.

Applicant traverses the Examiner’s rejections, including for the bases identified in Applicant’s Amendment Under 37 C.F.R. § 1.111, dated February 9, 2004, at pages 4-7.

Nonetheless, to facilitate prosecution of the present Application, Applicant has cancelled Claims 87-89 herein without prejudice.

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<sup>1</sup> Dresselhaus was published in 2001. The present application is a division of co-pending prior application Serial No. 10/000,746, filed on November 30, 2001, which is a continuation of prior application Serial No. 09/242,040 filed on September 13, 1999, which is the 35 U.S.C. § 371 national application of International Application Number PCT/US97/13896 filed on August 8, 1997, which designated the United States, claiming priority to provisional U.S. patent application Serial Number 60/023,732 filed on August 8, 1996. Thus, putting aside the benefits this application receives due to its provisional application, this application has at least an effective filing date of August 8, 1997. Accordingly, Dresselhaus is not prior art.

<sup>2</sup> There are only three instances under which a second reference can be used when making a §102 rejection. *See* M.P.E.P § 2131.01. The only one possibly pertinent here is the third instance, namely to “[s]how that a characteristic not disclosed in the reference is inherent.” *Id.*

**II. ALLOWED CLAIMS**

Examiner has indicated that the remaining claims in the Application (Claims 84-87) are allowed. Office Action, at 5.

**III. CONCLUSION**

As a result of the foregoing, it is asserted by Applicant that the Claims in the Application are now in a condition for allowance, and respectfully request allowance of such Claims.

Applicant respectfully requests that the Examiner call Applicant's attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,

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